

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM E. RYAN, JR., ROBERT K. GOTTLIEB
and JOSEPH D. MALLOZZI

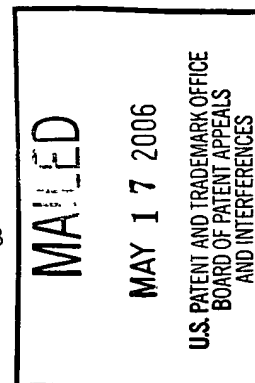
Application No. 10/036,991

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This Image File Wrapper (IFW) application was electronically received at the Board of Patent Appeals and Interferences on May 1, 2006. An in-depth review has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

INFORMATION DISCLOSURE STATEMENT

Appellants filed an Information Disclosure Statement (IDS) on December 31, 2001. It is not clear from the record whether the examiner fully considered the IDS submitted or whether the examiner notified appellants of why their submission did not meet



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the criteria set forth in 37 CFR §§ 1.97 and 1.98. Also there is no indication in PALM that the IDS has been added. Clarification and correction are required.

APPEAL BRIEF

Further review of the Image File Wrapper reveals that the Appeal Brief filed on August 30, 2005 does not comply with the new rules under 37 CFR § 41.37(c) because one of the required headings has not been included. 37 CFR § 41.37(c) states in-part:

. . . Appellant[s] must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

. . . .

. . . The brief shall contain the following item[] under [the] appropriate heading[] and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section . . .

. . . .

(x) **Related proceedings appendix.** An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section. [If this section does not apply then the word "None" can be placed under the heading.]

The following section is missing from the Appeal Brief filed August 30, 2005:

(11) Related Proceedings Appendix as stated in 37 CFR § 41.37(c)(1)(x).

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Further review of the Appeal Brief has determined that the content under the heading "Summary of Claimed Subject Matter" does not provide

[a] concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. [§] 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. [See 37 § CFR 41.37(c)(1)(v).]

It is required that a supplemental Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c)(1)(v) and 37 CFR § 41.37 (c)(1)(x).

EXAMINER'S ANSWER

The examiner's answer is required to include all **appropriate headings**, in the order indicated. However, the Examiner's Answer mailed December 6, 2005 fails to meet this requirement. **See the Manual of Patenting Examining Procedure (MPEP) § 1207.02(A)**, effective September 13, 2004. The following items are either missing or require clarification:

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The heading "(2) **Related Appeals and Interferences**" has been omitted, however, the word "None" is present and is presumed to be pertaining to this heading. Correction is required.

Also, the content under the heading "(8) **Evidence Relied Upon,**" contains a statement that "[n]o evidence is relied upon by the examiner in the rejection of the claims under appeal," but the examiner lists the references applied in the rejections on appeal (e.g., Stirling et al. U.S. 6,191,424 B1, published February 20, 2001 and Call et al. US 2002/0124664 A1, published September 12, 2002). Clarification on the written record is required pertaining to the this section of the Examiner's Answer.

Accordingly, it is

ORDERED that the application is returned to the examiner:

- 1) for consideration of the IDS filed on December 31, 2001, and to the IDS entered into the PALM system;
- 2) to provide written notification to appellants of consideration of IDS, and to have said consideration made of record;
- 3) to have the appellants submit a supplemental Appeal

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Brief in compliance with the new rules set forth in 37 CFR
§ 41.37(c);

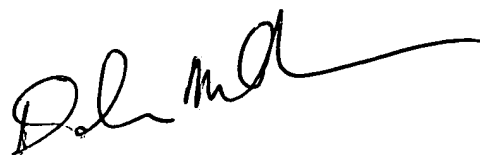
4) to have the supplemental Appeal Brief scanned into the
Official record;

5) to correct the errors and omissions in the Examiner's
Answer mailed December 6, 2005, supplying the appellants with
said corrected Examiner's Answer and ensuring that the Official
record is reflective of these changes; and

6) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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